

Remarks

This Reply is in response to the October 1, 2008 Office Action ("Office Action") issued in connection with the above-identified patent application. Reconsideration of the application in view of the following remarks is respectfully requested.

Summary of the Office Action

Claims 200-219 were pending in this application.

Claims 200-201, 205-207, 209-211, 215-217 and 219 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 5,485,221 ("Banker").

Claims 202-204, 208, 212-214 and 218 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of U.S. Patent No. 5,986,650 ("Ellis").

Summary of the Applicants' Reply

The Examiner's rejections of claims 200-219 are respectfully traversed.

Reply to the Rejections

The present invention, as defined by independent claims 200 and 210, relates to a system and a method for allowing a user of an interactive media guide to watch a program on a viewing device while simultaneously recording another program on a digital storage device. One of the components recited in claim 200 is an interactive television program guide implemented on user television equipment that is specifically configured to perform each of the following elements:

- cause said viewing device to display a program guide display;

- receive a user selection to watch a first television program indicated on said program guide display;
- receive a user selection to record a second television program indicated on said program guide display;
- cause said first tuner to tune to a channel corresponding to said first television program in order to cause said first television program to be displayed by said viewing device; and
- cause said second tuner to tune to a channel corresponding to said second television program in order to cause said second television program to be recorded by said digital storage device,
- wherein broadcast times of said first television program and said second television program overlap such that said first television program is displayed by said viewing device at the same time that said second television program is recorded by said digital storage device.

Thus, according to claim 200, the interactive program guide must be able to receive a user selection to watch a television program and record a program, as well as cause two tuners to tune to channels.

Applicants argued in the previous reply that Banker does not suggest how multiple tuners would or could work in the context of an interactive television program guide, let alone teaching an interactive television program guide that is configured to simultaneously cause a first tuner to tune to a first television program for viewing and cause a second tuner to tune to a second television program for recording by a digital storage device, as recited by applicants' independent claims.

The Examiner in the Response to Arguments section of current Office Action disagrees with applicants and states:

Banker shows that multiple tuners may be used in conjunction with user's desire to have interactive services provided them ... Said tuners work via user decision-making and selection which stems from use of an

interactive program guide ... which definitely shows how multiple tuners can work in context of a program guide. **Reading the claims in the broadest sense**, Banker certainly does [sic] multiple tuners working in the context of an interactive program guide. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. (Office Action, p. 2, emphasis in original).

Applicants would like to first remind the Examiner that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, (CCPA 1970) (MPEP § 2143.03). Applicants' prior arguments were based on limitations recited by applicants' claims. The Examiner's implication that applicants are reading limitations from the specification into the claims is wrong.

Second, the Examiner appears to be suggesting that applicants' claims would cover a user of Banker's system accessing listings using an interactive program guide and then separately issuing commands to tuners. This is not true. Applicants' claims require more than the mere existence of multiple tuners and an interactive program guide in a system. Applicants' claims require an interactive program guide that is configured to perform specific functions. These functions are missing from Banker as demonstrated below.

The Examiner cites to the following sections of Banker in the Response to Arguments section of the Office Action for allegedly teaching multiple tuners working in the context of a program guide: col. 6, lines 28-67, col. 11, lines 25-35, and col. 15, lines 35-50 (Office Action page 2). Contrary to the Examiner's allegations, these sections instead discuss the following: (1) downloading data for use in an electronic programming guide (Banker, col. 6, lines 28-67); (2) an onscreen display of instructions for how to use a subscriber terminal (Banker, col. 11, lines 25-35); and (3) using a microprocessor

to access virtual channels (Banker, col. 15, lines 35-50). Whether these sections teach multiple tuners working in the context of a program guide is not conceded, however, applicants submit that there is nothing in these sections that teaches all of the features specified for the interactive program guide of claim 200.

As mentioned above, claim 200 includes an interactive program guide that is configured to "receive a user selection to watch a first television program indicated on said program guide display." In the Office Action at page 3, the Examiner alleges that this element is taught by Banker at FIG. 5A, screen 100. Applicants disagree. Screen 100 depicts a main menu that includes several items, none of which are television programs. Furthermore, even though a user can navigate the menu screens to view additional information, the user cannot select a television program for viewing and Banker's EPG does not receive a user selection to watch a program. As shown in the Figures of Banker, the user can only navigate through screens of information or exit the menu. Thus, Banker fails to disclose an interactive program guide that is configured to receive a user selection to watch a first television program indicated on a program guide display.

The interactive program guide of claim 200 is also configured to "receive a user selection to record a second television program indicated on said program guide display." In the Office Action at pages 3-4, the Examiner alleges that this element is taught by Banker at col. 16, lines 33-37. Applicants disagree. The cited portion of Banker states the following: "the subscriber may view information displayed from one of the tuners and record on a VCR, for example, information from the other subscriber terminal. Accordingly, the subscriber is afforded an extremely wide range of combinations of programming

from only two frequency channels." (Banker, col. 16, lines 33-37.) There is no mention in this (or other sections of) Banker of an interactive program guide that is configured to receive a user selection to record a television program guide, as is specified by claim 200. Presumably, the user of Banker's system would manually set the VCR for recording as was well known in the art.

Claim 200 also recites that its interactive television program guide is configured to:

- cause said first tuner to tune to a channel corresponding to said first television program in order to cause said first television program to be displayed by said viewing device; and
- cause said second tuner to tune to a channel corresponding to said second television program in order to cause said second television program to be recorded by said digital storage device.

In the Office Action at page 4, the Examiner alleges that the above features are disclosed in Banker at col. 9, lines 33-51 and col. 16, lines 23-37. Applicants respectfully disagree. The first cited section describes providing "picture-in-picture capabilities or simultaneous watch and record, for example, multiple tuners (not shown) may be provided for tuning to more than one television channel simultaneously" (Banker, col. 9, lines 37-40). However, Banker does not elaborate on or explain how these services would be provided. The second cited section mentions two subscriber terminals which are coupled via their data ports, which may operate in a master-slave relationship, and whereby "the subscriber may view information displayed from one of the tuners and record on a VCR, for example, information from the other subscriber terminal" (Banker, col. 16, lines 32-35).

Thus, the only two-tuner system disclosed by Banker is one formed by connecting two single tuner subscriber terminals together. As discussed above, Banker fails to disclose that its single tuner subscriber terminal uses an electronic program guide to control its tuner. Banker further fails to disclose that its two-tuner system uses an electronic program guide to control the two tuners.

Instead, in the Banker system, a tuner (also called an up/down converter), "is tuned according to a channel selected by a subscriber via "a user interface having an infrared (IR) receiver 124, remote control 126, and/or terminal keypad 122." (Banker, col. 9, lines 52-54.) Although Banker includes an EPG, for which data is supplied to a headend and transmitted to subscriber terminals, the EPG data is provided only as text or as a message and is not described as having any controlling aspects. (Banker, col. 6, lines 28-29, 44-45.) Indeed, in Banker, the EPG is simply described as allowing "a subscriber to view a schedule of programming for the next several hours." (Banker, col. 17, lines 11-13.) There is no discussion in Banker of the EPG being used to cause a single tuner or multiple tuners to tune to a channel.

Thus, as discussed above, Banker fails to describe all of the features of the interactive television program guide of claim 200. For at least the above reasons, applicants request the 35 U.S.C. § 102(b) rejection of claim 200 be withdrawn. Claim 210 includes elements in common with claim 200 and is also allowable for the same reasons. Dependent claims 201-209 and 211-219 are also allowable for the same reasons.

Claims 209 and 219 include the following additional feature that patentably improves over Banker: "said first tuner and said second tuner are included in a single set-top box." The Office Action alleges that this feature is disclosed by

Banker at col. 9, lines 37-40 and FIG. 2. Applicants respectfully disagree. FIG. 2 shows only a single tuner 100. Banker at col. 9, lines 37-40 states that multiple tuners may be provided, however, Banker states that they are specifically not shown in the single subscriber terminal being discussed in the col. 9 passage. No other disclosure in Banker could be found of multiple tuners being provided in a single subscriber terminal. Instead, Banker specifically discusses using two subscriber terminals in order to provide picture-in-picture displays. (Banker, col. 16, lines 23-38.)

Claims 202-204, 208, 212-214 and 218 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Banker in view of Ellis. For at least the reasons discussed above with respect to claims 200 and 210, applicants submit that claims 202-204, 208, 212-214 and 218 are patentable over the cited references.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Prompt consideration and allowance of this application are respectfully requested.

Respectfully submitted,

/Pristine Johannessen/
Pristine Johannessen
Registration No. 55,302
Attorney for Applicants
Ropes & Gray LLP
Customer No. 75563